

**REMARKS**

Claims 1-3, 5, 6 and 8-28 are now pending in the application, with claims 1, 5, 8, 10, 11 and 15 being the independent claims. Reconsideration and further examination are respectfully requested.

Initially, Applicant thanks the Examiner for the indication that claims 1-3, 6, 8, 9, 15, 22, 23 and 26 are allowed and that claims 14, 24 and 25 recite allowable subject matter and would be allowed if rewritten into independent form. For the following reasons, Applicant believes that the other pending claims also should be allowed.

Independent claim 5 has been amended above to recite that the second rail is attached to the first rail at a position in addition to the common attachment to the dock element. This feature of the invention is supported, e.g., by cross rail 37, which is described on page 4 lines 10-12 and shown in Figure 1 of the Specification. Because claim 5 just now has been amended above to clearly recite this feature, such feature was not considered in the current Office Action. However, the applied art has been studied in detail and does not appear to disclose or to suggest this feature of the invention. Accordingly, independent claim 5 is believed to be allowable over the applied art.

Independent claim 10 is directed to an apparatus for use in an aquarium, in which is provided an attachment means for attaching a rail to a top edge of an aquarium so that the rail runs along an inside surface of a wall of the aquarium. A buoyant dock element has sliding means for attaching to the rail and for allowing the dock element to freely slide along the rail as a water level in the aquarium varies.

The foregoing combination of features is not believed to be disclosed or suggested by the applied art. In particular, the applied art does not disclose or suggest at least the feature of a rail,

upon which a buoyant docket element may freely slide, together with means for attaching the rail to the top edge of an aquarium.

In this regard, U.S. Patent 5,722,347 (Tominaga) describes a floating island that moves up and down with the water level along supporting rods that are attached with suction cups to the bottom surface or the side wall of an aquarium. As acknowledged in the Office Action, Tominaga does not show the use of an attachment means shaped as a hook extending outside of the aquarium. U.S. Patent 2,727,489 (Sklar) describes an aquarium fish-feeding station that is fixedly attached to the top edge of an aquarium by using a pair of hooks.

The Office Action asserts that it would have been obvious to use the hook of Sklar as an attachment means for the device of Tominaga "as a replacement of functional equivalents". However, this argument is believed to be inappropriate for the following reasons.

MPEP § 2144.06 provides, "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, *and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents.*" [Emphasis added]. One example given in § 2144.06 is In re Scott, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) (Claims were drawn to a hollow fiberglass shaft for archery and a process for the production thereof where the shaft differed from the prior art in the use of a paper tube as the core of the shaft as compared with the light wood or hardened foamed resin core of the prior art. The Board found the claimed invention would have been obvious, reasoning that the prior art foam core is the functional and mechanical equivalent of the claimed paper core. The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another, and in this case, the use of a light wood or hardened foam resin core does not fairly suggest the use of a paper core.)

In the present case, as noted in the Office Action, hooks have some generic functional equivalence to suction cups, i.e., in the very broad sense that they both can be used for attaching one element to another. However, there is absolutely no evidence of recognition in the applicable art that the two are equivalent for the purpose of supporting rods upon which a floating element can slide. Absent such recognition, it would not have been obvious to make the asserted substitution.

Moreover, Tominaga itself appears to teach away from any such substitution. The main embodiment described in Tominaga concerns an apparatus in which the supporting rods are attached to the bottom surface of the aquarium. When the disclosure goes on to describe alternatives, the only one that is mentioned it is an embodiment in which the supporting rods are bent at a right angle and attach to the side wall of the aquarium. Thus, Tominaga appears to teach that the supporting rods in an apparatus such as he describes should be supported at their bottom ends.

Still further, the top ends of Tominaga's supporting rods are decorated in each embodiment that he describes (e.g., to resemble palm trees in his preferred embodiments). Any replacement of his attachment means with hooks at the top ends of his supporting rods would have significantly changed his device and therefore, without any explicit suggestion to do so, would not have been obvious to one of ordinary skill in the art.

Finally, even if there were some motivation to combine the teachings of Tominaga and Sklar, there is nothing to indicate that the combination would have resulted in the present invention, as recited in independent claim 10. As noted above, Sklar only teaches the use of hooks for fixedly attaching an apparatus to the top edges of an aquarium. Accordingly, any permissible combination of Tominaga and Sklar more likely would have resulted in hooking

onto the top edge of the aquarium an island that is fixed in position (in the same manner that Sklar's feeding device is fixedly attached to the aquarium).

Based on the foregoing remarks, independent claim 10 is believed to be allowable over the applied art.

Independent claim 11 is directed to an apparatus for use in an aquarium, of the apparatus including a rail and support means for supporting the rail so that the rail extends into the aquarium from a location outside of the aquarium. A buoyant dock element has sliding means for attaching to the rail and for allowing the dock element to freely slide along the rail as a water level in the aquarium varies.

The foregoing combination of features is not believed to be disclosed or suggested by the applied art. For instance, for similar reasons to those set forth above with respect to independent claim 10, the applied art does not disclose or suggest at least the feature of support means for supporting a rail so that the rail extends into the aquarium from a location outside of the aquarium.

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In order to sufficiently distinguish Applicant's invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicant's invention. However, no attempt has been made to categorize each unobvious difference. Applicant's invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such

elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

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